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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,500	01/11/2005	Hamdy A Elwakil	AD6907USPCT	9254

7590 08/11/2006

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT PAPER NUMBER

1774

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/521,500

**Applicant(s)**

ELWAKIL ET AL.

**Examiner**

Betelhem Shewareged

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-22, drawn to method of making, classified in class 156, subclass 230.
  - II. Claims 23-35, drawn to decorative laminate, classified in class 428, subclass 32.1.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, (i.e., printing on a surface of an interlayer using an electrophotographic image printing method, laminating the printed interlayer between two sheets of transparent materials).
4. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Maria Kourtakis on 07/31/2006 a provisional election was made with traverse to prosecute the invention of Group II, claims 23-35. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 1-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

7. Claims 23, 31, 34 and 35 are objected to because of the following informalities:

A: In claim 23, the value of the Frequency is provided with out a measuring unit.

B: In claims 23 and 31, the use of the abbreviations "PY", "PV", "PR", "PB" and "PBI" render the claims ambiguous. The abbreviations are neither defined in the specification nor do they have a well defined meaning in the art.

C: In claim 23: the use of the term "low" renders the claim ambiguous. The term is neither defined in the specification nor does it have a well defined meaning in the art. The necessary degree of low viscosity has not been defined.

D: In claims 34 and 35: the use of the abbreviations "PVB", "PET" and "PUR" render the claims ambiguous.

8. Appropriate corrections are required.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

10. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

11. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 23-35 are rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claims 23-35 of U.S. Patent No.

10/878,572. Although the conflicting claims are not identical, they are not patentably distinct from each other because current claims 23-35 correspond to claims 23-35 of '572.

13. Claims 23-27 are rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claims 1, 9, and 16 of U.S. Patent No.

10/913,714. Although the conflicting claims are not identical, they are not patentably distinct from each other because current claim 23 corresponds to combination of claims 1 and 9, and current claims 24-27 correspond to combination of claims 1, 9 and 16.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 23-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snelgrove (US 4,303,718) in view of Menzel et al. (US 6,596,067 B2).

16. Snelgrove discloses polyvinyl butyral interlayer printed with ink jet ink laminated in a glass sheet (col. 1, lines 5-26; col. 3, line 14; and claims 1, 3 and 4). With respect to the value of the surface roughness, the value of roughness frequency, the value of the adhesive strength and the value of the Delta E, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Snelgrove reference teaches Applicant's claimed ink jet ink printed polyvinyl butyral interlayer, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Snelgrove does not disclose the claimed pigment in the ink jet ink.

17. Menzel teaches an ink jet ink comprising a pigment such as Pigment Red 122, Pigment Yellow 120, Pigment Yellow 155, Pigment Yellow 180, Pigment Blue 15:3 and

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Pigment Blue 15:4 (col. 5, lines 40-44), a dispersant such as surfactant (col. 5, line 6), and a binder (col. 5, line 9).

18. Snelgrove and Menzel are analogous art because they are from a similar problem solving area, in relation to, ink jet ink. At the time of the invention, it would have been obvious to a person or ordinary skill in the art to combine the ink jet ink of Menzel with the invention of Snelgrove in order to provide an ink composition that has carefully harmonized physical properties such as surface tension, viscosity and electrical conductivity to render it suitable for generating droplets and controlling their direction of flight, and another important requirement is that the ink may not form any solids, even on evaporation of any constituent of the recording fluid or when the chemical composition of the ink changes during storage, during recording or during a recording pause (col. 1, lines 25-41 of Menzel).

### ***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

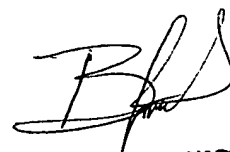
20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B.S.  
August 6, 2006.

BETELHEM SHEWAREGED  
EXAMINER



BETELHEM SHEWAREGED  
PRIMARY EXAMINER